

Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

Claim Rejections - 35 USC § 103

Claims 1-20 stand rejected under 35 USC §103(a) as being unpatentable over *Cosman* (U.S. 6,405,072) in view of *Whitehurst* (U.S. 6,733,485). Withdrawal of the rejection is respectfully requested for at least the following reasons.

In rejecting claim 1, the Examiner admits that *Cosman* fails to teach inductively stimulating at least one implant, and effectively admits *Cosman* fails to teach determining, based on a detected emission from the inductively stimulated implant, a position of the at least one implant. However, the Examiner contends that *Whitehurst* teaches the above features, and that it would have been obvious to one having ordinary skill in the art to combine the teachings of *Cosman* and *Whitehurst*. Applicants respectfully disagree with the Examiner's rejection of claim 1 for at least the followings reasons.

Whitehurst

Whitehurst discloses an implantable stimulator that includes electrodes for delivering electrical stimulation to surrounding tissue and/or a pump for delivering a drug to surrounding tissue. The device includes a power/data circuit for receiving power and/or data from outside the body by inductive, radio frequency or other electromagnetic coupling. In use, the device provides electrical stimulation and/or administration of a drug based on predetermined parameters, which may be stored in the implant.

Positionally referencing the implant

Claim 1 recites positionally referencing at least one implant in the vicinity of the target region. In addressing this feature, the Examiner contends it is shown in Fig. 6 of *Whitehurst*.¹ Fig. 6 of *Whitehurst*, which is reproduced below, illustrates a programmer/recharger located outside of the body, and several stimulators 150A, 150B and 150C inside the body. According to *Whitehurst*, stimulators 150A and 150B provide a substance to the patient, while stimulator 150C provides electrical stimulation.²

¹ Page 2, last paragraph of the Office Action

² See column 20, lines 32-61 of *Whitehurst*

Nowhere in the discussion of Fig. 6, however, is there any mention of **positionally referencing the stimulators**. Further, the remaining portions of *Whitehurst* also have not been found to teach this feature. Accordingly, the cited art has not been shown to teach positionally referencing at least one implant in the vicinity of the target volume as set forth in claim 1 and, thus, a *prima facie* case of obviousness has not been established for claim 1.

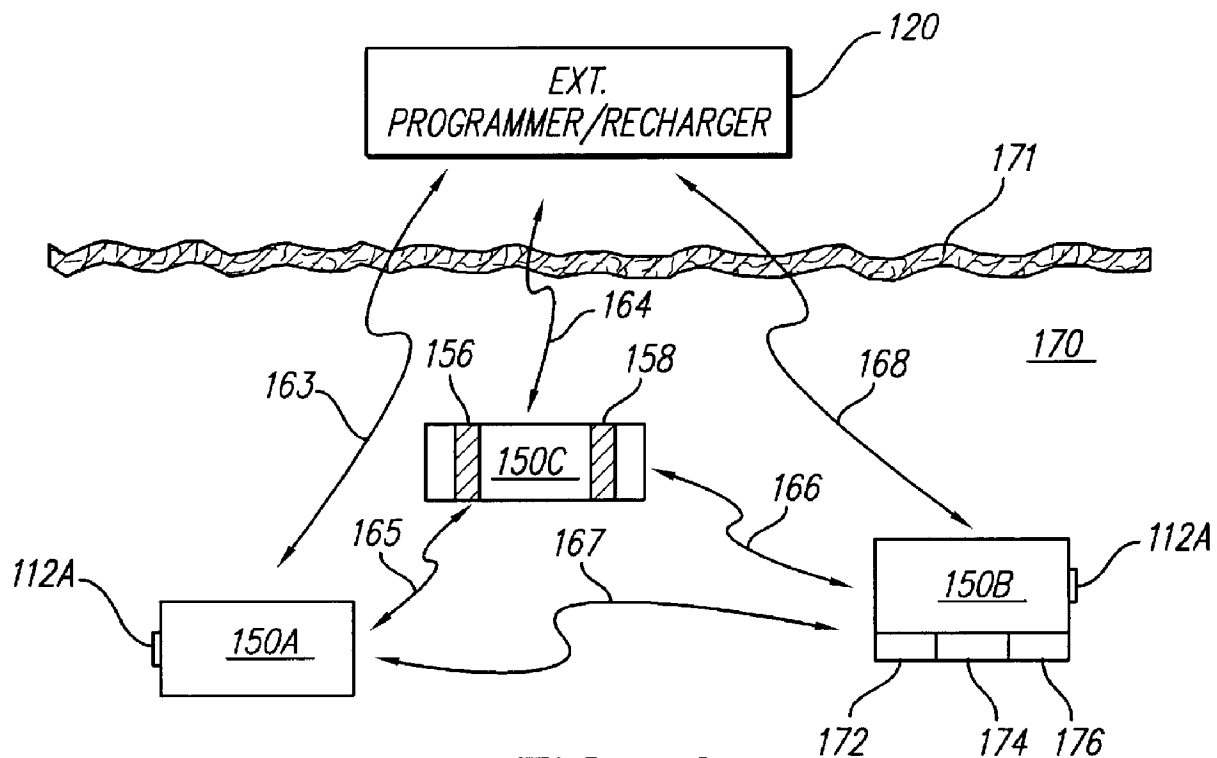


FIG. 6

Determining a position of the implant

Claim 1 also sets forth that a position of the at least one implant is determined based on a detected emission from the implant. The Examiner does not indicate where this feature is allegedly disclosed in *Whitehurst*. Instead, the Examiner only states stimulating implanted elements provide further indication of a location.³ It is respectfully submitted that *Whitehurst* is silent with respect to **determining a position of the implant**, let alone determining such position **based on an emission from the implant**. Further, and as noted above, the Examiner effectively admits *Cosman* does not teach

³ See page 3, first paragraph of the Office Action

determining, based on a detected emission from the inductively stimulated implant, a position of the at least one implant.

Accordingly, *Cosman* in view of *Whitehurst* also does not teach or fairly suggest determining a position of the at least one implant based on a detected emission from the implant as set forth in claim 1.

The above reasoning is also applicable to distinguish claim 19 from *Cosman* in view of *Whitehurst*.

Accordingly, withdrawal of the rejection of claims 1 and 19, and the claims dependent therefrom, is respectfully requested.

Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,
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